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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,330	10/22/2003	Istvan Boldogh	265.00390101	1384
26813 7590 01/18/2007 MUETING, RAASCH & GEBHARDT, P.A. P.O. BOX 581415 MINNEAPOLIS, MN 55458			EXAMINER KAM, CHIH MIN	
			ART UNIT 1656	PAPER NUMBER
			MAIL DATE 01/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/691,330

Applicant(s)

BOLDOGH ET AL.

Examiner

Chih-Min Kam

Art Unit

1656

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-6, 8 and 12-15.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's reply does not overcome the rejection of claims 1-6, 8 and 12-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U. S. Patent 6,500,798, claims 1-10 of U. S. Patent 6,903,068, or 1-7 of U. S. Patent 7,119,064.

Continuation of 13. Other: In the response filed December 22, 2006, applicants indicate that the Examiner has improperly relied on the teachings of the instant specification. According to MPEP § 804, when considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art; that obviousness-type double patenting rejection is inconsistent with the Restriction Requirement. The present application was subject to a Restriction Requirement (2/8/05), the method claims of 1-23 were placed in three different restriction groups, Groups I-III because the method steps and outcomes are wholly different among the three groups as indicated by the examiner; that in the double patenting rejection over claims 1-8 of U. S. Patent No. 6,300,798, the Examiner is improperly using the teachings of the specification to substantiate a rejection under the judicially created doctrine of obviousness-type double patenting. Further, the method steps and outcomes of pending claims 1-6, 8, and 12-15 differ from the method steps and outcomes of claims 1-8 of U.S. Patent No. 6,500,798. Thus, the methods cannot be obvious one over the other; that in the double patenting rejection over claims 1-10 of U. S. Patent No. 6,903,068, the Examiner is improperly using the teachings of the specification to substantiate a rejection under the judicially created doctrine of obviousness-type double patenting. Further, the method steps and outcomes of pending claims 1-6, 8, and 12-15 differ from the method steps and outcomes of claims 1-10 of U.S. Patent No. 6,903,068. Thus, the methods cannot be obvious one over the other; and that in the double patenting rejection over claims 1-7 of U. S. Patent No. 7,119,064, the Examiner is improperly using the teachings of the specification to substantiate a rejection under the judicially created doctrine of obviousness-type double patenting. Further, the method steps and outcomes of pending claims 1-6, 8, and 12-15 differ from the method steps and outcomes of claims 1-7 of U.S. Patent No. 7,119,064. Thus, the methods cannot be obvious one over the other (pages 2-11 of the response).

Applicants' response has been fully considered, however, the arguments are not found persuasive because of the following reasons. While MPEP § 804 states that when considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art, it also states that "This does not mean that one is precluded from all use of the patent disclosure, the specification can always be used as a dictionary to learn the meaning of a term in the patent. In re Boylan 392 F.2d 1017, 157 USPQ 370 (CCPA1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variations of an invention claimed in the patent. In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619,622 (CCPA1970). The teachings of instant specification such as "UV-irradiation is a major cause of oxidative stress in the cells and may induce apoptosis" (Example 8; pages 28-29), colostrinin induces a variety of cytokines in leukocytes or modulates cytokine production (page 8, lines 11-15; page 22, lines 32-33; page 29, lines 24-30), and 4-HNE (4-hydroxynonenal) induce apoptosis (Example 7; page 28)" are used to indicate the effects of colostrinin or its constituent peptides when administered to cells in the obvious-type double patent rejection. Thus, the citation of teachings of the instant specification is not improper. Regarding the Restriction Requirement in the instant application, for consistency, Examiner would withdraw the restriction requirement if the claims of Groups II and III are presented. Since the claimed methods of the instant application contain the same method step (i.e., contacting the cell with an effective amount of colostrinin, a constituent peptide of colostrinin or combination thereof) as the claimed methods in the U. S. Patent No. 6,500,798, 6,903,068 or 7,119,064, thus the claimed methods of instant application are obvious variations of the claimed methods of these three patents. Further, in the prosecution of U.S. application no. 09/641,801 (now U.S. patent 6,903,068), a terminal disclaimer has been filed over U.S. Patent 6,500,798.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Bragdon can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Primary Patent Examiner



CHIH-MIN KAM
PRIMARY EXAMINER

CMK
January 11, 2007